REMARKS

This is in full and timely response to the above-identified Office Action. Reexamination and reconsideration in light of the proposed amendments and the following remarks are respectfully requested.

Claim Status

Claims 1-24 stand provisionally rejected for double patenting;

Claims 1-10, 17-18, 22-23 stand rejected under 35 USC § 102;

Claims 11-16 and 19-21 stand rejected under 35 USC § 103;

Claim 24 stands rejected only under double patenting; and

Claims 25 and 26 are newly added.

Claim Amendments

In this response claim 24, inasmuch as this claim is not rejected under either of §§ 102, 103, and contains subject matter which is not claimed in the copending application 09/925,649, it is assumed to be free of any question of double patenting and allowable. This claim has therefore been amended to assume independent form. Claims 1 and 22 have been amended to improve clarity of the subject matter set forth therein.

Double Patenting

The provisional double patenting rejection is traversed. The independent claims in USN 09/925,649 differs from those pending in the instant application at least because they require a request for authorization and a detection of the authorization. That is to say, claim 1 of USN 09/925,649 is as follows:

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> A printing method, comprising the steps of:
> receiving data at a printer;
> detecting a network address in the received data;

> if a network address is detected, then **displaying or
>   sending a message** notifying of the network
>   address detection **and requesting authorization
>   to access the network address**;
> if **authorization to access is received**, sending on the
>   Internet or other network an access request for a
>   document to the network address;
> retrieving the document from the network address; and
> printing the document. (Emphasis added)

It is submitted that the claims in the instant application ('650) and those pending in USN 09/925,649 are different to the degree that any question of double patenting is rendered moot. For example, the independent claims of this application require a determination if a URL or external network option is enabled, the independent claims of USN 09/925,649 do not. The independent claims of USN 09/925,649 require that if a network address is detected, then a message is either displayed or sent notifying of the network address detection. These claims further require a request for authorization to access the network address to be included in this message. The independent claims of this application ('650) do not contain these limitations and therefore do define the same subject matter.

It is further submitted that this issue can only be effectively resolved when the claims in both applications are allowed and/or in condition for allowance and a comparison of the claims is meaningful. It is additionally pointed out that USN 09/925,649 was filed on the same day as the instant application and thus further renders both the effect and need for a terminal disclaimer, moot.

Rejections under 35 USC § 102

The rejection of claims 1-10, 17-18, and 22-23 under 35 USC §102(e) as being anticipated by Tabata et al. (USP 6,537,324), is respectfully traversed.

In this rejection, the Examiner takes the position that with respect to claims 1, 5 and 22, Tabata et al. discloses a printing method comprising receiving data at a printer (470B). In support of this, the Examiner quotes column 23, lines 56-63 of Tabata et al. However, a review of this section of the reference reveals that the Examiner's position is not supported by this disclosure.

Firstly, it must be noted that the Tabata et al. reference, at column 23, lines 10-12, discloses that a copying machine 470 comprises <u>a scanner unit</u> 470A as a "correlated information identifying unit" and <u>a printer</u> 470B as an "<u>output unit</u>" and that the two units are integrated into one device. It is pointed out that this reference continuously discloses the scanner and printer as being different devices. Therefore, the fact that they are integrated into a single arrangement cannot be taken to mean that the scanner is a printer or *vice versa.*

It is pointed out that the disclosure of column 23, lines 56-63 of Tabata et al., upon which the anticipation of the first step recited in the independent claims, is founded, does <u>not</u> disclose the printer *per se* receiving any data. In fact, this section indicates that it is the <u>scanner</u> unit that reads the medium and reads a code area 206 which is on the medium as raster information. More specifically, column 23, lines 56-63, discloses:

> Then, the medium form 420 with the mark(s) 51 added thereto is **read by the scanner unit** (correlated information identifying unit) 430 or 470A (S2101). In this case, each of the **scanner units** 430, 470A **reads a code area 206 from the medium form 420 as raster information** and also reads a text section with the mark(s) 51 added thereto. With those operations, linkage information and selection information are supposed to be read.

It is therefore clear that if data is "received", it is "received" by the scanner and not the printer.

The rejection is untenable in that it is impermissible to assert that, because a copying machine includes a printer and a scanner, that the scanner, which scans the medium and derive data therefrom, anticipates the claimed step of a <u>printer</u> receiving data which is able to include address information (note the third step of claim 1, for example).

It is submitted that the first step of "receiving data at a printer", in the context of the claim taken as a whole, is not anticipated by Tabata et.

The rejection continues with the assertion that the Tabata et al. reference anticipates the second of the claimed steps and determines "whether an external network option is enabled" or not. The rejection states that this feature is disclosed at column 24, lines 14-17. However, what is disclosed is the <u>scanner</u> unit(s) transferring data pertaining to the address, to a file server 440. That is to say, the section of Tabata et al. discloses:

> Then, each of the **scanner** units identifies described
> position information (Refer to FIG. 7 and FIG. 8) from the
> coordinate values of the mark 51, identifies an address
> (URL) of the correlated information file from the
> corresponding address information, and transfers **and**
> **outputs the address to a file server** 440 (S2102).
> (Emphasis added)

It is submitted that it is untenable to rely on the an act of transferring information to a server to anticipate the act of determining whether a network option is enabled or not. The determination of an operability is distinct and separate from the act of using the operability and transferring a file. In fact, the act of transferring the file cannot even be relied upon to suggest that at some stage there was an attempt to determine if a network option was enabled or not. Indeed, the transmission would have to be sent with the expectation that it may fail and it would have to be determined if the transmission failed or not before any semblance of a test per se would exist.

There is no disclosure that the act of transferring data to the file server 440 is a <u>test</u> to determine if it can be transferred or not. Therefore, it cannot be assumed for the sake of rejection that routine data transfer is a <u>test</u> to determined if the data can be transferred or not. There is, therefore, neither anticipation nor suggestion of <u>determining</u> whether a URL or external network option <u>is enabled</u> or not.

The third step recited in claim 1 calls for detecting if a network address is contained in the data received by the printer. The rejection is such as to rely on the disclosure of Tabata et al. at column 23, line 56 – column 24, line 17. However, this disclosure is as follows:

> Then, the medium form 201 with the mark(s) 51 added thereto is read by the scanner (reader) 60 (S1201). In this case, the **scanner 60 reads a code area 206** from the medium form 201 as raster information and also reads a text section with the mark(s) 51 added thereto. With those operations, linkage information and selection information are supposed to be read.

> The network terminal equipment (retrieving unit) 70 decodes, when **having received the code area 206 read by the scanner** 60 as well as image data for the text section, the two-dimensional bar code of the code area 206 using the two-dimensional bar code decoder in the correlated information identifying section and obtains the HTML source code of the original hypertext and linkage information or the like, and then, develops the decoded HTML source code to raster information using the HTML source code developing software, extracts a difference between the developed raster information and the raster information in the read text section using the marking identifying software, obtains an image for the mark

(selection information) 51 as well as a noise image (a
slight displacement between the two raster information),
further removes the noise image by filtering, and identifies
the mark (selection information) 51. Then, the network
terminal equipment 70 identifies described position
information (Refer to FIG. 7 and FIG. 8) from the
coordinate values of the mark 51, and **identifies an
address (URL) of the correlated information file from
the corresponding address information (S1202).**
(Emphasis added)

Thus, it is clear that it is data which is supplied to the <u>scanner</u> as different from
the printer, which is used to identify an address (URL).

Attention is called to the fact that Tabata et al. at column 28, line 35 – column 29,
line 6, discloses the following:

Then, **the scanner unit** (correlated information identifying
unit) 430 identifies a file server by searching for an
available file server (S2602), and determines whether the
available file server is a file server 440 as a correlated
information file retrieving unit or a file server 520 as a
correlated information file identifying/retrieving unit
(S2603).

When it is determined that the available file server is the file
server (correlated information file retrieving unit) 440, the
**scanner unit 430 decodes a two-dimensional bar code
of the code area 206, develops the decoded HTML
source code to raster information**, extracts a difference
between the developed raster information and the raster
information in the read text section, obtains an image for
the mark (selection information) 51 as well as a noise

image (a slight displacement between the two raster
information), further executes filtering thereto, and identifies
the mark (selection information) 51. Then, the **scanner
unit** identifies described position information, **identifies an
address (URL) of the correlated information file from
the corresponding address information, and transfers
and outputs the address to the file server 440 (S2102).**

The **file server** (correlated information file retrieving unit)
440 **retrieves an appropriate correlated information file
from the appropriate file device 410 according to the
address (URL)** of the correlated information file (S2103),
and transfers the retrieved correlated information file to the
printer 460 (S2104). **However, when the correlated
information file itself is found to be a hypertext**, as it is
required to output the correlated information file as medium
form information, the **file server 440 prepares medium
form information from the hypertext and transfers the
medium form information to the printer 460 (S2105).**
(Emphasis added)

Thus, the only time that the printer is disclosed as receiving data is the receipt of
data from the file server and this is only carried out after the <u>scanner</u> has identified the
URL. In other words, the printer is disclosed as being supplied with data which would
be expected to contain only printing instructions and nothing more. In other words, the
printer is there to print and is not disclosed as serving any other function.

In order for a *prima facie* case of anticipation to be established a single reference
must disclose each and every one of the claimed steps. Vague innuendo and inference
cannot be used in place of clear concise disclosure.

At least the first three of the steps recited in claims 1 and 22 have not been
identified as being disclosed. Simply by way of example, the use of a data transmission

cannot be tenably held to either expressly or inherently describe a test to determine whether a URL or external network option is enabled or not and cannot be relied upon to enable a case of *prima facie* anticipation to be established.

Thus, in summary the Tabata et al. reference fails to disclose, in the manner necessary to establish a *prima facie* case of anticipation, that information, which is derived by scanning with the scanning unit 470A, is in fact ever received by the printer 470B. The fact that the scanning and printing units are integrated into a single copying machine 470 does not negate the fact that they are referred to as separate devices throughout the disclosure of Tabata et al., and does not allow the presumption that if the scanner receives or generates data, that the printer is going to receive the same. In fact, it is highly likely that the printer never receives this information. The utility of transferring information which is derived from the scanner to the printer <u>without printing</u> is, in fact, pointless.

Further, the act of transferring data to a server does not at all disclose or suggest the act of inquiring as to network operability. A test to determine if a network is available neither anticipates nor renders obvious a transfer of data over a line which is fully expected to be constantly in full and reliable operation. There must be an expectation of a possible failure before "testing" in the sense claimed, is disclosed/suggested.

In addition, the position that the Tabata et al. reference discloses detecting if a network address is in the data which is received at the <u>printer</u>, is untenable. As noted above, in Tabata et al., the only data which is supplied to the printer comes from a server and would, absent any disclosure to the contrary, have to be presumed to be simply printing instructions.

Rejections under 35 USC § 103

1)   The rejection of claims 11-14 under 35 USC § 103(a) as being anticipated by Tabata et al. in view of Russell et al. is traversed. This rejection falls with the fall of the anticipation rejection of claim 1. .Further, the teachings of Russell et al. do not overcome the clear shortcomings which are introduced by the "interpretations" of the disclosure

and how the claimed subject matter of the parent claims is inappropriately held to be anticipated.

2)   The rejections of claims 15 and 16 and 19-21 under 35 USC § 103(a) as being unpatentable over Tabata et al. in view of Wolff, are respectfully traversed on the same grounds as the rejection of claims 11-14.

Newly added Claims

In this response, independent claims 25 and 26 have been added. These claims find support in at least originally filed claims 1 and 22 and are patentable over the art in that they call for a series of steps which are neither disclosed in nor rendered obvious by the disclosure of the art of record.

Conclusion

It is submitted that this application is in condition for allowance. Favorable consideration of the newly presented claims along with those rejected in this Office Action, are respectfully requested.

Respectfully submitted,

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